



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,467	04/09/2004	John Melideo	J000-P03231US	1089

33356 7590 10/24/2006

SoCAL IP LAW GROUP LLP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE, CA 91362

EXAMINER

BAUTISTA, XIOMARA L

ART UNIT	PAPER NUMBER
----------	--------------

2179

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,467

Applicant(s)

MELIDEO, JOHN

Examiner

X. L. Bautista

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>9/14/06</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/27/06</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-60 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 41 is objected to because of the following informalities: the claim has been amended but has a wrong status. Appropriate correction is required.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-60 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-33 of copending Application No. 10/614,394 and claims 1-33 of copending Application No. 10/840,889. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-5, 7-19, 21-25, 27-39, 41-45 and 47-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cho et al* (US 6,834,048 B1), *Bertacchi* (US 5,790,638) and *Slotznick* (US 7,058,356 B2).**

Claims 1 and 41:

Cho discloses a method for initiating Internet telephone calls from a web page. Cho explains that users may search the Web for contact phone numbers and that the invention facilitates selection of phone numbers by using an input device and that it provides an automated, interactive and immediate real-time call connection capability for the web page user to the individual or business (col. 3, lines 50-67; col. 4, lines 1-13). Cho teaches that to place a call to a telephone number the caller selects the phone number by clicking on the underlined or highlighted text (ad, dial link), (col. 6, lines 44-50). Cho teaches that character strings indicative of a telephone number are modified into a link and then the system displays the telephone number (col. 1, lines 56-67). Cho teaches selecting and activating the link and initiating the telephone call to the telephone number

represented by the link (col. 2, lines 1-11; col. 7, lines 1-15).

Cho does not teach generating a call trigger for initiating a multi-leg phone call. However, Bertacchi discloses a system and method for controlling initiation of secondary telephone numbers. The system is responsive to an incoming call made to a primary telephone number subscribing to a call transfer service feature. The invention responds to an incoming call made to a primary phone number by simultaneously calling specified secondary numbers (multi leg calling), (abstract; col. 1, lines 60-67; col. 2, lines 1-8, 44-61). Therefore, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to modify Cho's method for initiating phone calls to include Bertacchi's teaching of placing a multi-leg phone call because a user can be reached at any of a plurality of specified telephone numbers maximizing the chance of being reached anywhere at any time. Cho/Bertacchi does not teach that the user telephone number and the merchant telephone number are distinct and separate from each other and the computing device. However, Slotznick discloses a method of establishing two-way communication between a user and a remotely located entity. Slotznick teaches a computer system having a computing device (computer; set-top box) for enabling a two-way communication between the user and a merchant (col. 5, lines 14-23); a set-top box for receiving and forwarding the telephone numbers displayed on the monitor (fig. 12; col. 15, lines 4-24; col. 2, lines 40-67; col. 3, lines 1-61; col. 4, lines

21-25), a TV phone that may be used as an input device (col. 11, lines 20-23) and for receiving phone numbers that may be transmitted by a wireless transmitter (col. 2, lines 47-63); a phone service that is used for transmitting the phone call to a merchant (col. 13, lines 36-47; col. 15, lines 4-24), and a cellphone that may be used by the user for receiving a telephone call from the merchant (col. 7, lines 27-54; col. 15, lines 4-24). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Cho/Bertacchi's method of establishing a two-way communication to include Slotznick's teaching of using three or more different devices for transmitting, making and receiving telephone calls because it enables the merchant to reach the user through different telephone devices whenever one is not available.

Claims 2, 22 and 42:

See claim 1. Cho teaches a computer (having input device, display device, processor, and a memory) having a display screen and software for displaying a web page (figs. 5A-5B; col. 4, lines 15-65).

Claims 3, 5, 23, 25, 43 and 45:

Cho teaches a designated telephone number being a link to an Internet telephone service provider (col. 6, lines 44-50).

Claims 4, 24 and 44:

Bertacchi teaches that in response to an incoming call the system determines

by querying a database, whether the telephone associated with the primary number subscribes to a call transfer calling service feature (col. 2, lines 44-50).

Claims 7, 8, 27, 28, 47 and 48:

See claim 1. Cho teaches the invention comprises accessing a web page using a browser (col. 1, lines 56-60).

Claims 9, 29 and 49:

Cho teaches receiving a phone number entered or selected from a previously entered phone number (col. 1, lines 56-67; col. 2, lines 1-11; col. 4, lines 3-14; col. 6, lines 44-50).

Claims 10, 30 and 50:

Cho teaches activating a dial link by clicking on the link (col. 6, lines 44-50).

Claims 11 and 51:

See claim 1. Cho shows in figure 5B a web page displaying links having ad data including content information, address, and telephone number. Slotznick teaches a web page; links for accessing content information; and ad content information (Cho: col. 4, lines 26-41; col. 8, lines 12-31; Slotznick: figs. 1A and 1B).

Claims 12, 32 and 52:

See claim 1. Cho teaches a character string (col. 1, lines 56-67) and URLs (col. 4, lines 24-49).

Claim 13, 33 and 53:

See claim 1. Cho teaches a user being enabled to access the Internet and search a web site by using a client computer (figure 1A-1B).

Claims 14, 34 and 54:

Cho teaches triggering instructions included in the dial link (col. 4, lines 24-49).

Claims 15, 16, 35, 36, 55 and 56:

See claim 11. Cho and Slotznick teach instructions for displaying a page (Cho: fig. 5A; Slotznick: figs. 1A and 1B).

Claims 17, 37 and 57:

Cho and Slotznick teach a merchant identifier (fig. 5A; Slotznick: figs. 1A and 1B).

Claims 18, 19, 38, 39, 58 and 59:

Cho and Slotznick teach a web page having telephone numbers (fig. 5A; Slotznick: figs. 1A and 1B).

Claims 21 and 31:

See claim 11. Cho and Slotznick teach a computer (fig. 1A) having display screen, input device, processor, memory and display screen.

7. **Claims 6, 20, 26, 40, 46 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cho/Bertacchi/Slotznick* and *Musk et al* (US 6,185,194 B1).**

Claims 6, 20, 26, 40, 46 and 60:

Cho/Bertacchi/Slotznick teaches tracking usage and charging the user for providing content (Slotznick: col. 9, lines 47-58; col. 16, lines 54-67; col. 17, lines 1-10) but it does not teach sending a message to a billing system to charge the merchant for the user activating the dial link. However, Musk discloses a system and method for initiating telephone calls using Internet initiation. Musk teaches that a web site accessed to place a call has a directory with a phone icon for a business to allow call initiation; the web site contains billing information and the business directory provides reverse billing and can be used to bill the business for the telephone call instead of the user (col. 2, lines 1-8; col. 3, lines 1-14). Thus, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to modify Cho/Bertacchi/Slotznick's method and system for initiating telephone calls between a first and second phone numbers to include Musk's teaching of charging and billing a merchant for a telephone call when the user activates a dial link because it is a real incentive and it is very convenient; users can communicate with the merchant easily and quickly while saving money and they also save time because they don't have to spend time dialing telephone numbers.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Tuesday-Friday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

xl
October 20, 2006


LUCILA X. BAUTISTA
PRIMARY EXAMINER